

Remarks

Status of the Application and Claims

The present application was originally filed on October 7, 1994 and had a total of 6 claims. As the result of a restriction requirement, all of these except for claim 1 were canceled. In a response to an Office Action filed by Applicants on August 1, 1995, new claim 7 was added.

A file wrapper continuation was filed on June 6, 1997 and a request for continued prosecution was filed on March 20, 1998. In a subsequent response to an Office Action, Applicants submitted two Declarations by inventor Udo Görl in which data was presented comparing the properties of rubber compounds made using precipitated silica according to the invention with similar compounds made according to references cited by the Examiner.

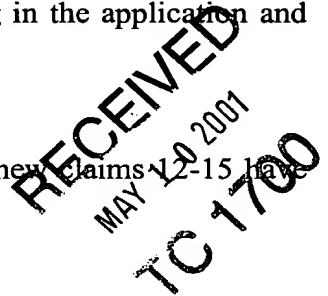
Claim rejections were appealed by Applicants and an Appeal Brief was filed on July 28, 1999. The application was subsequently withdrawn from appeal as the result of the filing of a request for continued prosecution on November 30, 2000. At the same time, a Preliminary Amendment was filed canceling the claims then pending in the application and adding new claims 8-11.

In the present response, claims 8-11 have been canceled and new claims 12-15 have been added. These are the claims presently pending in the application.

II. The Amendments

Claims have been amended so that they are now directed to vulcanized rubber compounds incorporating precipitated silicas rather than being directed to the silica itself. New claim 11 is supported by original claim 8 and by page 5 of the specification, lines 28-29. Claims 13-15 correspond to canceled claims 9-11.

The amendments made herein do not add new matter to the application and their entry is therefore respectfully requested.



The Rejections

I. Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph

On page 2 of the Office Action, the Examiner rejects claim 8 as being indefinite due to the inclusion of the word "good." Since this language is no longer in the claims as amended herein, this basis of rejection has been obviated.

The Examiner also questions the use of the word "fineness" in claims 10 and 11 (now claims 14 and 15). Applicants submit that this term is not be unclear to one of skill in the art in light of the definition provided on page 9 of the application, lines 21-32. This reads in part:

Particle fineness is characterized by the average, volume-weighted particle diameter MTG (D(4.3)) measured by laser diffraction (Malvern Instruments, model 2600c). Values of $\leq 11 \mu\text{m}$, in particular of $\leq 10 \mu\text{m}$, are achieved for the silicas according to the invention, which are higher than for customary silicas ($\geq 12 \mu\text{m}$).

In light of the above, Applicants submit that the term "fineness" is not indefinite and respectfully request that the Examiner's rejection be withdrawn.

II. Rejection of Claims Under 35 U.S.C. § 102/103, First Paragraph

On page 2 of the Office Action, the Examiner rejects all pending claims under 35 U.S.C. § 102(b), or in the alternative, under 35 U.S.C. § 103. The rejections are based upon either of two references, Lagarde, *et al.* (U.S.C. 4,704,425) and Johnson, *et al.* (U.S.C. 4,681,750). These same references were previously used to reject claims and the rejections were the subject of an Examiner's Answer. In the present Office Action, the Examiner notes that "intended use does not limit the product claimed."

Applicants respectfully traverse this rejection for amended claims 12-15. A separate discussion with respect to sections 102 and 103 may be found below.

A. Rejection of Claims Under 35 U.S.C. § 102

In order to reject claims under 35 U.S.C. § 102, a single reference must teach all of the elements of a claimed invention either expressly or inherently. In the present case, neither of

the references cited by the Examiner *expressly* teach all of the elements of the present claims. Nevertheless, the Examiner appears to suggest that all of the elements not expressly taught can be presumed to be present from the properties that *are* disclosed, *i.e.* that the undisclosed elements are inherent.

Applicants do not agree with this conclusion. In order to be inherent, an element must be the necessary consequence of that which is expressly taught in a reference. This is clearly not the case for the claimed invention. For example, one cannot conclude what the pore volume of precipitated silica will be based upon the BET surface area. The Examiner alleges that the "fineness is deemed possessed since the other properties appear to be." However, it should be noted that the claims as amended herein are directed to vulcanized rubber compounds and the Declarations that have been previously filed by Applicants clearly show that the properties of compounds made according to the cited references are *not* the same. In fact, side-by-side experiments demonstrate that the claimed product is substantially different with respect to important characteristics.

In light of the above considerations, Applicants submit that the present rejection of claims with respect to 35 U.S.C. § 102 cannot be reasonably maintained. It is therefore respectfully requested that this rejection be withdrawn.

B. Rejection of Claims Under 35 U.S.C. § 103

In the present Office Action, the Examiner indicates, in essence, that the fitness of a product for a particular use is inherent in its composition. This is correct. However, the reverse is also true, *i.e.*, the physical characteristics of a product are a reflection of its composition. As discussed above, Declarations have been filed which demonstrate substantial differences between the rubber compositions of the present invention and those made according to the references cited by the Examiner.

With respect to Lagarde the comparison demonstrated, *inter alia*, differences with respect to abrasion loss and reinforcement behavior (see page 6 of Declaration). The results led the Declarant to conclude that rubber compositions made according to the present

invention are different from, and exhibit marked advantages, relative to compositions made according to Lagarde (see paragraph 7 of the relevant Declaration).

A second Declaration was filed in which a side-by-side comparison was performed using compositions made according to the Johnson reference. Again, substantial differences were observed (see paragraph 5 of the relevant Declaration for a detailed discussion) and the Declarant concluded that compositions made according to the present invention have substantial advantages (see paragraph 6 of the Declaration).

The Declarations indicate that one cannot justifiably conclude that the cited references disclose a rubber composition having either the same chemical composition as that presently claimed or that the differences that exist are not significant. In this regard it should be appreciated that the characteristics studied in the comparisons are of clear practical importance with respect to the intended use of the present invention. Thus, the allegations that claims are anticipated (*i.e.* that the references disclose an identical invention) or obvious (*i.e.*, that the references disclose inventions that are substantially the same) cannot be reasonably maintained.

Conclusion

In light of the amendments and discussion above, Applicants submit that all of the Examiner's rejections under 35 U.S.C. §§ 112, 102, and 103 have been overcome. It is therefore respectfully requested that these rejections be withdrawn and that the claims presently pending in the application be allowed.

If, in the opinion of the Examiner, a phone call may help to expedite the prosecution of this application, the Examiner is invited to call Applicant's undersigned attorney at (202) 861-3020.

Respectfully submitted,

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